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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/716,843	11/19/2003	Sanjay Patel	S1177/20047	7093

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EXAMINER

WOODWARD, ANA LUCRECIA

ART UNIT PAPER NUMBER

1711

DATE MAILED: 08/14/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/716,843

Applicant(s)

PATEL, SANJAY

Examiner

Ana L. Woodward

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on June 8, 2006
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-49 is/are pending in the application.
- 4a) Of the above claim(s) 3, 8-13, 21-23 and 25-49 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 4-7, 14-20 and 24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Election/Restrictions***

1. This application contains claims 25-49 drawn to an invention nonelected with traverse in the reply filed on December 8, 2005. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.
2. Claims 3, 8-13 and 21-23 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected species of composition or group, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on December 8, 2005.

### ***Claim Rejections - 35 USC § 112***

3. Claims 1, 2, 4-7, 14-20 and 24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 2, the metes and bounds of “a molecule other than the PAA” are indeterminate in scope. For example, it is unclear as to whether or not said molecule can be another molecule of the “crosslinker”.

In claim 14, the language “one of the two other molecules” lacks express antecedent basis.

In claim 15, given that “said molecule other than the PAA” can be “another molecule of the crosslinker” (per claim 2), it is unclear how said crosslinker can be characterized as a “further” component.

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In claims 16, 17 and 19, the language “the cross-linkable molecule” lacks express antecedent basis.

***Claim Rejections - 35 USC § 102/103***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 18-20 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over U.S. 4,832,808 (Buchwalter) as per reasons of record.

Buchwalter discloses reaction products of a polyimide, inclusive of polyamide-imides reading on the presently claimed PAI, and a polyamine, reading on the presently claimed “at least one molecule other than a PAA or PAI”.

The disclosure of the reference meets the requirements of the above-rejected claims with respect to the types of materials added. The onus is shifted to applicants to establish that the product of the present claims is not the same as or obvious from that set forth by the reference.

7. Claims 18-20 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over U.S. 5,133,840 (Buchwalter et al) as per reasons of record.

Buchwalter et al disclose polyamic acids having carboxyl groups (inclusive of polyamide-imides), reading on the presently claimed PAI, and their reaction with epoxy compounds, hydrazines and hydroxyl-functional compounds, reading on the presently claimed “at least one molecule other than a PAA or a PAI”.

The disclosure of the reference meets the requirements of the above-rejected claims with respect to the types of materials added. The onus is shifted to applicants to establish that the product of the present claims is not the same as or obvious from that set forth by the reference.

***Claim Rejections - 35 USC § 103***

8. Claims 1, 2, 4-7, 14-20 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. 6,479,581 (Ireland et al).

Ireland et al disclose aqueous-based coating compositions comprising a product formed of the combination of a polyamide-amic acid (PAA) and a triamine. The polyamide-amic acids are described as having a high acid number (column 3, lines 3-7), thus reading on the presently claimed PAA. The triamine neutralizes the amic acid functionality (column 3, lines 46-50) and, as such, reads on the presently claimed neutralizing agent. Furthermore, the composition may be used in combination with other resins such as, for example, polyurethane, polyepoxy and polyacrylate-based sizing compositions, reading on the presently claimed “directly linkable molecule” (column 10, lines 40-44). It would be expected that said additional resins would undergo a condensation reaction with the carboxyl groups due to their reactive moieties.

The disclosure of the reference differs in essence from the present claims in not expressly exemplifying the use of the additional resin reading on the presently claimed “directly linkable molecule”. It is maintained that it would have been obvious to one having ordinary skill in the

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art to have further combined the polyamide-amic acid and triamine with said additional resin for its expected additive effect as a sizing composition. Accordingly, absent evidence of unusual or unexpected results, no patentability can be seen in the presently claimed subject matter.

### ***Response to Arguments***

9. Applicant's arguments filed June 8, 2006 have been fully considered but they are not persuasive.

Regarding Ireland et al, their composition may further contain an additional resin such as, for example, polyurethane, polyepoxy and polyacrylate-based sizing compositions, reading on the presently claimed "directly linkable molecule" (column 10, lines 40-44). It would have been obvious to one having ordinary skill in the art to have further combined the polyamide-amic acid and triamine with said additional resin for its expected additive effect as a sizing composition.

Regarding the Buchwalter et al references, polyamide-imides are clearly taught as suitable components, which clearly read on the presently claimed PAI.

### ***Conclusion***

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

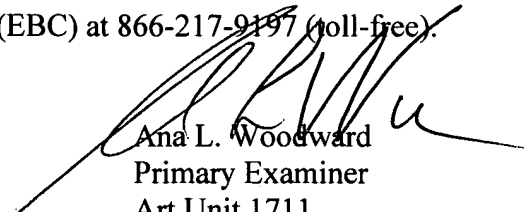
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will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ana L. Woodward whose telephone number is (571) 272-1082. The examiner can normally be reached on Monday-Friday (8:30-5:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James J. Seidleck can be reached on (571) 272-1078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Ana L. Woodward  
Primary Examiner  
Art Unit 1711

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